



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/307,295 05/01/99 WILDE

G 901033-1001

EXAMINER

PM82/0411

DANIEL F. PERLZ  
GARDERE & WYNNE LLP  
3000 THANKSGIVING TOWER  
1601 ELM STREET  
DALLAS TX 75201-4762

LEE, J

ART UNIT

PAPER NUMBER

3673

DATE MAILED:

04/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/307,295

Applicant(s)  
Wilde et al.

Examiner  
Jong-Suk (James) Lee

Group Art Unit  
3673

☒ Responsive to communication(s) filed on Feb 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 30-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 30-41 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number:09/307,295

Art Unit: 3673

---

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20

**DETAILED ACTION**

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 3673**.

2. The amendment filed on February 24, 2000 has been entered.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation, "the shaft" in line 2 lacks proper antecedent basis. It appears to be the element of "the frame" as recited in claim 33.

Appropriate correction is required.

Serial Number:09/307,295

Art Unit: 3673

---

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 30, 31, 35-38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Corley.

Corley discloses a buoy (5) adapted for submerged use comprising of: a frame having a first end and second end, shaft (13) and a first plate/fixed plate and second plate (14, 15), the shaft (13) having a plurality of spaced apart holes along a portion of the length of the shaft that receive a fastener/pin (26); a first buoyancy member (A) mounted on the frame; a plurality of second buoyancy members/ third, fourth, fifth buoyancy member (B) removably mountable on the frame, the greater or lesser number of the second buoyancy members may be used as desired; means for securing/fastener (17,19,26) the second buoyancy member on the frame; means/first and second pad eyes (18) located at the first and second ends of the frame for securing the buoy (5); the buoyancy members are made up of any suitable light material that possesses a very high buoyant effect, such as balsa wood (see Figs. 1-2 and attached figure; pg.1, lines 68-110; pg.2, lines 1-110). With respect to the second through fifth buoyancy members, these members are removably mounted to the frame so that the buoyancy members may be determined before the

Serial Number:09/307,295

Art Unit: 3673

---

1 buoy is completely assembled.

2  
3 *Claim Rejections - 35 USC § 103*

4 7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness  
5 rejections set forth in this Office action:

6 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
7 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
8 such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
9 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
10 manner in which the invention was made.

11 This application currently names joint inventors. In considering patentability of the claims  
12 under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was  
13 commonly owned at the time any inventions covered therein were made absent any evidence to  
14 the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor  
15 and invention dates of each claim that was not commonly owned at the time a later invention was  
16 made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35  
17 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).  
18

19 8. Claims 32-34 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
20 Corley in view of Havlick. The teachings of Corley have been discussed above.

21 Corley fails to disclose or fairly suggest the buoyancy members are formed from syntactic  
22 foam. Havlick discloses buoy construction comprising a buoy (10) formed from urethane foam  
23 (36) (see Fig.1-2; col.2, lines 44-63; col.3, lines 51-54).

24 Therefore, in view of Havlick, it would have been obvious to one of the ordinary skill in  
25 the art at the time the invention was made to modify Corley's buoyancy material by replacing with

Serial Number:09/307,295

Art Unit: 3673

---

1 syntactic foam, such as urethane foam as taught by Havlick in order to reduce the manufacturing  
2 cost and enhance the buoyancy proficiency.

4 *Response to Arguments*

5 9. Applicant's arguments with respect to claims 30 and 35 have been fully considered but  
6 they are not persuasive. With respect to applicant's argument such that Corley's reference  
7 discloses a permanent assembly having one or more buoyancy members permanently cemented  
8 together to form the buoy and even if the sections of Corley were considered to be removably  
9 mountable, the buoyancy of the buoy of Corley is not variable, it is more limited than the claim  
10 scope. As far as number for the buoyant members is variable as desired while it is being  
11 manufactured, it would provide variable buoyancy. Further, to change the buoyancy of the buoy  
12 with a second buoyancy member removably mountable on the frame was merely considered to be  
13 desired results of the buoy assembly.

14  
15 *Allowable Subject Matter*

16 10. Claim 40 would be allowable if rewritten to overcome the rejection(s) under 35  
17 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the  
18 base claim and any intervening claims.

Serial Number:09/307,295

Art Unit: 3673

---

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached between the hours of 7:30AM to 6:00PM Monday thru Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis, can be reached on (703) 308-3248. The fax phone number for this Group is (703) 305-3597.

Serial Number:09/307,295

Art Unit: 3673

---

1 Any inquiry of a general nature or relating to the status of this application or proceeding  
2 should be directed to the Group receptionist whose telephone number is (703) 308-2168.

3  
4 Jong-Suk (James) Lee *JS*

5 April 4, 2000

6 Attachment: Fig. 2 of Corley (US 1,295,008)



Eileen Dunn Lillis  
Primary Examiner